Paper No. 31

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROTOSHI FUJISAWA

Appeal No. 1997-3960
Application 08/249,700

ON BRIEF

Before JERRY SMITH, BARRETT and BARRY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 12 and 14, which constitute all the claims remaining in the application. An amendment after final rejection was filed on March 31, 1997 in response to a new ground of rejection set forth in the examiner's answer. This amendment was entered by the examiner.

The disclosed invention pertains to a disc cartridge for use with a disc apparatus which is capable of determining whether the inserted cartridge contains an optical disc or a magneto-optical disc. More particularly, the type of disc is determined by discriminating the height of a recess on a lateral side of the disc cartridge.

Representative claim 12 is reproduced as follows:

12. A disc cartridge for use with a miniature disc shaped recording medium, the disc shaped recording medium having a diameter of 64 mm, comprising:

a cartridge main body for accommodating the disc shaped recording medium, the cartridge main body defining a plurality of positioning pin engagement holes on a major surface thereof; and

a discriminating section formed in the cartridge main body for discriminating the type of disc shaped recording medium accommodated within the cartridge main body, wherein the discriminating section is a recess which is formed in a lateral side of the cartridge main body adjacent one of said positioning pin engagement holes, the lateral side of the cartridge main body being different from, and perpendicular to, the major surface of the cartridge main body, a height of the recess designating the type of disc shaped recording medium accommodated within the cartridge main body, the height of the recess being detectible by external detecting means to control a position of an external magnetic field generating means of a disc recording and reproducing apparatus as a function of the detected height of the recess when the cartridge main body is loaded into the disc recording and reproducing apparatus.

The examiner relies on the following references:

Motoyama et al. (Motoyama)	4,837,758	June 06, 1989
Suzuki	4,876,619	Oct. 24, 1989

Claims 12 and 14 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Motoyama in view of Suzuki. A first basis for this rejection was set forth in the final rejection, and a second basis for this rejection was set forth in the examiner's answer as a new ground of rejection. The new ground of rejection was withdrawn in the supplemental examiner's answer in response to the amendment noted above.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answers for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answers.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the

particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 12 and 14. Accordingly, we reverse.

Appellant has indicated that for purposes of this appeal claims 12 and 14 will stand or fall together as a single group [brief, page 4]. Consistent with this indication appellant has made no separate arguments with respect to either of the claims on appeal. Accordingly, claims 12 and 14 will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against independent claim 12 as representative of both of the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive

at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp.,
732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.;
In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by

appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to representative, independent claim 12, the examiner cites Motoyama as teaching a disc cartridge for use with a disc apparatus which is capable of determining whether the inserted cartridge contains an optical disc or a magneto-optical disc. In other words, the Motoyama device makes the very same discrimination as the disclosed invention. The examiner acknowledges, however, that Motoyama fails to teach the disc having a diameter of 64 mm, the recess formed in the lateral side of the cartridge, the height of the recess determining the type of disc within the cartridge, and the positioning pin engagement holes as recited in claim 12 [answer, pages 3-4]. The examiner cites Suzuki as teaching the use of positioning pin engagement holes in a disc cartridge, and the examiner asserts the obviousness of using such pin positioning holes in the Motoyama apparatus. With respect to the remaining acknowledged differences between the invention of claim 12 and the teachings of Motoyama, the examiner simply declares that each of these differences would have been obvious to the skilled artisan [id., pages 5-6].

Appellant argues that the examiner has failed to establish a prima facie case of obviousness. More specifically, appellant argues that the examiner has simply dismissed all the differences between the claimed invention and the teachings of the prior art as obvious within the meaning of 35 U.S.C. § 103 without any teaching or suggestion within the applied references [brief, pages 5-13]. Appellants argue that the examiner's rejection is nothing more than an attempt to reconstruct the invention using hindsight.

We essentially agree with appellant's position as set forth in the main brief. Although the examiner's rejection attempts to find rationales for modifying the applied prior art, these rationales are all based on achieving appellant's invention rather than on suggestions coming from the prior art. The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch,
972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). We agree with appellant that the only suggestion on this record for modifying the disc cartridge of Motoyama in the manner

proposed by the examiner comes from appellant's own specification.

Since the applied prior art and the examiner's analysis do not establish a prima facie case of the obviousness of the claimed invention, we do not sustain the examiner's rejection of claims 12 and 14 based on Motoyama and Suzuki. Therefore, the decision of the examiner rejecting claims 12 and 14 is reversed.

REVERSED

Jerry Smith Administrative Patent Judge	)	
Lee E. Barrett Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Lance Leonard Barry Administrative Patent Judge	)	

JS/cam

Philip M. Shaw, Jr.
Limbach & Limbach
2001 Ferry Bldg.
San Francisco, CA 94111